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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,480

10/02/2003

Thomas Robert Burke

TBURK01

2479

33310 7590 06/28/2006

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EXAMINER

MAHMOUDI, HASSAN

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/605,480	BURKE, THOMAS ROBERT	
	Examiner	Art Unit	
	Tony Mahmoudi	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. The instant application claims benefit of the filing date to the U.S. Provisional Application S/N 60/415,099, filed on 02-October-2002. Accordingly, the filing date of the Provisional Patent Application (02-October-2002) is considered the effective filing date for the examination of the instant application.

Oath/Declaration

2. The Oath/Declaration filed on 02-October-2003 is objected to because of the following informalities:

The Declaration, at the bottom of page 1 identifies Mr. Edwin A Skoch II as both "Attorney" and an "Inventor." However, the second page of the Declaration, and the Application Data Sheet (also filed on 02-October-2003) both list Thomas R. Burke as the only inventor. Clarification on the actual inventor name(s) is required.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because at least one reference character has been used to designate multiple entities throughout the drawings. For example, reference character "18" has been used as a label for a mainframe computer in figure 1, and it has been used to designate "Sender" in figure 2. If the two entities are indeed the same, they should have the same label or the same symbol. The applicant is required to review and correct all sheets of the drawings as appropriate.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because *none of the reference characters* (numeric and/or alphabetic reference/identifiers) are mentioned anywhere in the disclosure of the instant application. The applicant is required to review and correct all sheets of drawings as appropriate, in view of the descriptions within the specification.
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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6. The drawings are further objected to because of the following informalities:

In figure 1, the elements appearing on the right side of mainframe 14 need to be labeled.

The drawing figures are not numbered sequentially (e.g., there are no drawing figures 16 and 17.)

Drawing figure following figure 15A needs to be numbered/labeled as figure 15B, based on its contents which point back to figure 15A.

Drawing figure following the figure 15B (needing to be labeled as 15B per above) needs to be numbered/labeled. This figure is also missing some characters/letters from the contents (e.g., “custome” needs to be “customer”.) The second box seems to have a connection line to a reference not shown in the drawing.

Some descriptions for drawing elements contain spelling errors (e.g., Box 32 in figure 2 is labeled “authoriizer”).

The Applicant is required to ensure correct spelling of all reference labels and descriptors used in the figures of drawings.

Correction of figures of drawings is required in view of the guidelines provided in section 608.02 of the MPEP.

Specifications

7. The Abstract of the disclosure is objected to because of the following informalities:

Several words within the Abstract either contain spelling errors or need to be separated by spaces (e.g., “entity's” in line 5; “typesFigures” and “Figuresentity” both in line 12.

Appropriate corrections are required.

8. The Specification of the instant application is objected to because of the following informalities:

In page 2 of the Summary of Invention (line 4), “an non-intrusive” needs to be changed to --a non-intrusive--. Correction is required.

In the Brief Description of Drawings section, only figure 1 is described, while the Application includes 12 sheets of drawings, with figure number as high as 18 (see above objections to the numbering of claims). The Applicant is requested to briefly describe all included drawing figures in the application. See M.P.E.P, section 608.01(f).

The Detailed Description section should provide detailed information about the invention as it relates to the figures of drawings. According to section 608.01(g) of the MPEP:

“This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation.”

“The description is a dictionary for the claims and should provide clear support Or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01.”

The Applicant is requested to provide details of the claimed invention as illustrated by the enclosed figures of drawings, based on the guidelines provided in the above referenced sections of the MPEP.

9. The specification of the instant application is further objected to, in view of the objections made above to the drawings. The specification must correctly and sufficiently reference every element shown on the drawing figures. Wherever there is a discrepancy between an element depicted in the drawings and references made to the element in the specification (or lack thereof), either the figures of drawings, or the specifications, or both must be corrected to overcome the discrepancy. Appropriate corrections to the specifications are required.

Claim Objections

10. Claim 1 is objected to because of the following informalities:

Claim 1 contains many spelling, typographical, and grammatical errors. Due to the extent of these errors, the examiner is listing claim 1 *exactly as submitted* with the original filing (below). All spelling and typographical errors are marked in boldface Italic format and all grammatical errors (phrases) are boldfaced and underlined. Re-writing of this claim and correcting all the listed errors is required.

The following is the exact copy of independent claim 1 of the instant application, as originally filed:

[c1] A system for returning contact information of one type in response a query having *differetn contatt* information of the same type, for the *amentint*, comprising: a data storage means for storing data; a date *ofabas* contact *infoion* *rmatfor* a plurality of entities *ion* which resides in said data means; *afirst,,* means for receiving one or more queries, each comprising *at ment ofone ele* contact info for an *mationcipient*; a *seco,,nd* means for accessing and searching said database that *(pares* the *contactl* contact information in said query to the of said *databaidentifies* *contactal* contact information *sairrelated* to said *entityd* Recipient in said query, identifies alternate *contactonal* contact information of the same *typrelated* to the *entitythe* Recipient; and, a third means for responding to queries that returns, in *respquery*, different *contactersonal* contact information of the same type, said different *contactpersonal* contact *informang* to *torresponenti-* *tye* same Recipient as said query.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the ***first paragraph*** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 1 as originally filed, is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification does not provide any support or teachings as to how the invention is made and used. None of the functional elements of the claim, for example, none of the three “means” of the claim (“a first means for receiving one or more queries”, “a second means for accessing and searching said database”, and “a third means for responding to queries”) are taught or even mentioned in the specification.

The Detailed Description section of the specification only briefly discusses the preferred embodiment of the present invention, without any detailed description of the invention as illustrated in the enclosed figures of drawings, and it does not provide any information which would enable a person with ordinary skill in the art to make and use the invention.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the ***second paragraph*** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 1 as originally filed, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 as originally filed, contains several spelling, typographical, and grammatical errors, which make it difficult to comprehend the claim as a whole and render the claim indefinite.

There are several limitations lacking antecedent basis in the originally filed claim. To show a few examples, the limitation of “***said data means***” in lines 5-6; the limitation of “***said database***” in line 9; and the limitation of “***said entitid***” in line 11 all have insufficient antecedent basis in the claim.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claim 1 as originally filed, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Originally filed claim 1 recites three means as, “a first means for receiving one or more queries”; “a second means for accessing and searching said database”; and “a third means for responding to queries”.) The above “means” are not defined anywhere in the originally filed specification of the instant application, and therefore, can be interpreted as “software” means or “software” modules which, without dependence on appropriate hardware, are considered ***non-statutory*** subject matter as ***software*** per se.

Also, the claim as originally filed, does not produce a ***concrete*** and ***tangible*** result. The claim features three means, ending with “a third means for responding to queries *that* return different contact information of the same type”. The “responding to the queries” seems to be done conditionally (responding is only done to “queries *that return different contact information of the same type*”). There is ***no*** indication of any ***result*** if the queries don’t “return different contact information of the same type” (or they return various different results, e.g., return different contact information of a different type). Therefore, the conditional result of “responding” is not considered ***concrete***.

The conditional result discussed above is not communicated (i.e., displayed or printed) to a user. Neither is an indication of any such result stored anywhere in memory. The conditional result takes place transparently and therefore, is not considered *tangible*.

Any amendment(s) to the claim to overcome the above rejections under 35 U.S.C. 101, requires sufficient support in the originally filed specification of the instant Application.

Examiner's Interpretation of the Claim

17. For the purpose of searching for (and applying) prior art in this examination, the following interpretation of the claim (by the Examiner) is provided upon carefully reviewing and attempting to unscramble the erroneous words, to the extent possible. The claim examined in the sections following, is solely based on the Examiner's interpretation of claim 1, as follows:

1. A system for returning contact information of one type in response a query having different contact information of the same type, for the entity, comprising:

a data storage means for storing data;

a database of contact information for a plurality of entities, which resides in said data means;

a first means for receiving one or more queries, each comprising one element of contact information for a recipient;

a second means for accessing and searching said database that compares the contact information in said query to the one of said database, identifies contact information related to

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said entity in said query, identifies alternate contact information of the same type related to the entity; and

a third means for responding to queries that returns, in response to query, different contact information of the same type, said different contact information to correspond to same recipient as said query.

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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19. Independent claim 1 of the instant application is provisionally rejected under the judicially created doctrine of double patenting over claim 1 of Burke (Serial Number 10/605,488, U.S. Publication No. 2004/0133561 A1) since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

INSTANT APPLICATION 10/605,480	Burke (10/605,488; US 2004/0133561 A1)
<p>1. A system for returning contact information of one type in response a query having different contact information of the same type, for the entity, comprising:</p> <p>a data storage means for storing data;</p> <p>a database of contact information for a plurality of entities, which resides in said data means;</p> <p>a first means for receiving one or more queries, each comprising one element of contact information for a recipient;</p> <p>a second means for accessing and searching said database that</p> <p>compares the contact information in said query to the one of said database,</p> <p>identifies contact information related to said entity in said query,</p> <p>identifies alternate contact information of the same type related to the entity; and</p> <p>a third means for responding to queries that returns, in response to query, different contact information of the same type, said different contact information to correspond to same recipient as said query.</p>	<p>1. A system for returning contact information of one type in response a query having different contact information of the same type, for the entity, comprising:</p> <p>a data storage means for storing data;</p> <p>a database of contact information for a plurality of entities, which resides in said data storage means;</p> <p>a first means for receiving one or more queries, each comprising at least one element of contact information for each entity;</p> <p>a second means for accessing and searching said database that</p> <p>(d1) compares the contact information in said query to the contents of said database,</p> <p>(d2) identifies contact information in said database related to said entity in said query, and</p> <p>(d3) identifies alternate contact information of the same type as said query which is related to the entity; and</p> <p>a third means for responding to queries that returns, in response to said query, different contact information of the same type as query, said different contact information corresponding to the same entity as said query.</p>

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As shown above, claim 1 of Burke (Serial Number 10/605,488, U.S. Publication No. 2004/0133561 A1) contains every element of claim 1 of the instant application and as such, anticipates claim 1 of the instant application.

“A later application claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

21. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Hertzog et al (U.S. Publication No. 2003/0069874, hereinafter referred to as Hertzog.)

As to claim 1, Hertzog teaches a system for returning contact information (see paragraphs 2, 33 and 40-41, where “returning is read on “synchronization”; and “contact information” is read on “personal information”) of one type in response a query having different contact information of the same type (see paragraphs 70 and 99), for the entity, comprising:

a data storage means for storing data (see figure 1, and see paragraph 42, where “storage, publishing, and synchronization of personal information is taught as functions of the PIM; and see paragraphs 47, 50, and 213);

a database of contact information for a plurality of entities, which resides in said data means (see figure 1, and see paragraphs 37, 45, 56, 65 and 67);

a first means for receiving one or more queries, each comprising one element of contact information for a recipient (see paragraph 127, where “a query comprising one element of contact information” is read on “query embodying personal information”; and where “receiving” is read on “communicated”; and see paragraphs 131, 134, and 203);

a second means for accessing (see paragraphs 45, 50 and 75-76) and searching (see paragraphs 110-113, 134 and 170) said database that compares the contact information in said query to the one of said database (see paragraph 56, where “comparing” is read on “matching”, and see paragraph 170, where “generating a message indicating that a match is found” requires a “comparison”), identifies contact information related to said entity in said

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query (see paragraphs 89-96), identifies alternate contact information of the same type related to the entity (see paragraphs 70, 89-96, and 99); and

a third means for responding to queries that returns, in response to query, different contact information of the same type, said different contact information to correspond to same recipient as said query (see paragraph 114; and see figure 9A and paragraph 123, where “responding” is read on “displaying”; and see paragraphs 130 and 132.)

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to methods and systems of searching and identifying alternate user personal (contact) information in general:

Patent/Pub. No.	Issued to	Cited for teaching
US 2003/0110223 A1	Hamilton et al.	Extracting email data fields and retrieving alternate contact information based on said data fields.
US 2004/0268265 A1	Berger	Database query for user address and alternate user information.

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23. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.



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